

BERND LUHMANN ET AL.
USSN 09/988,548

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

Claims 12-23 were rejected under 35 USC § 101 as claiming the same invention as that of claims 1-12 of U.S. Patent No. 6,372,335. In response, Applicants notice that the Examiner concedes that the claims of the patent contain the limitation “a backing *consisting of a single* layer foam material,” whereas the instant claims contain no such limitation. Therefore, the instant claims could embrace a backing comprising or consisting of a *multiple* layer foam material, whereas Applicants submit that the claims of the patent could not embrace a multiple layer foam material. The Examiner points out that the patent claims are open-ended, and recite the open-ended term “comprising.” However, Applicants point out that patent claims define the backing using the close-ended term “consisting of,” and then specify that the self-adhesive composition is coated on one of both sides of “said backing.” Consequently, whereas the instant claims could embrace a double-sided adhesive tape comprising adhesive applied to both sides of a multiple foam layer material, the patent claims could not embrace such a double-sided adhesive tape because the requirements that (a) the backing consists of a single layer foam material and

BERND LUHMANN ET AL.
USSN 09/988,548

(b) the adhesive is applied to both sides of "said backing," i.e., the single layer foam material.

The use of the term "comprising" does not, under the circumstances of this case, trump the use of the term "consisting of," and, thereby, open up the patent claims to the use of backings that are not single layer foam materials. To do so would make a mockery of the very language that the Examiner himself relied upon in allowing the earlier patent. In short, the Examiner's position is untenable, and, therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. (The second paragraph on page 2 of the Office Action indicates that the rejection could be overcome by "amending the conflicting claims so they are no longer coextensive in scope. Since the claims already are not coextensive in scope for the reasons given above, the rejection should be withdrawn.)

Claims 24-35 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,372,335. In response, Applicants respectfully request that this issue be held in abeyance until allowable subject matter is indicated at which time Applicants will either prove patentable distinctness or file a suitable terminal disclaimer.

Claims 12-35 were rejected under 35 USC § 103(a) as being obvious over WO 95/06691 (hereinafter "the cited reference" or "Bries"). In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. The Examiner points to the preliminary amendment at page 9, lines 8-17, and then implies that Applicants argued that an

BERND LUHMANN ET AL.
USSN 09/988,548

inherency/obviousness rejection is presumptively improper. Applicants made no such argument. Instead, Applicants argued that the Examiner had not established either inherency or obviousness, and, therefore, the claims were patentable over the prior art under either theory.

Especially with respect to claims 24-35, Applicants point out that claim 24 requires:

“the backing is selected such that the backing would tear if pulled in the absence of said self-adhesive composition with the same stripping force necessary to remove said adhesive tape from said substrate, but the backing does not tear when said adhesive tape is removed from said substrate.”

In order for a rejection based on inherency to be proper, the Examiner was required to show that this limitation was *necessarily* met in the adhesive tapes of the cited reference. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In the preliminary amendment, Applicants pointed out that the Examiner had not discharged this burden. Thus, Applicants stated that: “It certainly is not the case that the backings of Bries must *necessarily* satisfy [this limitation] of present claim 24, and, consequently, that limitation cannot be inherent in Bries.”

On the issue of obviousness, Applicants responded that this limitation of claim 24 was not taught or suggested by the cited reference because the cited reference expressly taught away.

BERND LUHMANN ET AL.
USSN 09/988,548

Thus, Applicants argued that: "Further, [this limitation] could not possibly be an obvious modification of Bries, as Bries expressly teaches away from the use of backings which would tear under the force necessary to release the tape from the substrate."

Unfortunately, the Examiner misconstrued Applicants' position, and because the Examiner misconstrued Applicants' position he did not deal with the substance of Applicants' arguments, and Applicants respectfully request that he treat and respond to those arguments now. Moreover, Applicants respectfully request that the next Office Action not be made final since Applicants should be able to respond to the Examiner's response to their arguments as a matter of right, and not at the Examiner's discretion, as would be the case if, for example, the next Office Action is made final.

On the inherency issue, Applicants seek a response from the Examiner why the backings of the cited reference must *necessarily* be of a type that would tear when the tape was removed from a substrate if it were not for the presence of the adhesive composition. Certainly, backings can be selected or constructed that would *not* tear under such conditions. Consequently, Applicants do not believe that the backings of the cited reference are *necessarily* of a type that would tear. And, unless they are *necessarily* of a type that would tear, then the reference does not inherently anticipate the instant claims.

On the issue of obviousness, Applicants repeat that the cited reference expressly teaches

BERND LUHMANN ET AL.
USSN 09/988,548

away from the instant constructions, and, therefore, there is no obviousness. As can be taken from Bries at page 1, last line, and page 2, first line, the backing material and thickness is chosen so that the backing does not rupture before the tape is completely removed from the substrate. This same object is repeated at page 2, lines 12-13 and 25-26. Thus, in all of Bries embodiments, the backing thickness and material is chosen so that it must not rupture. This idea is repeated throughout Bries, for example, at page 5, lines 14-15, wherein it is taught that the polymeric film layer is used to increase "the load bearing strength and rupture strength of the tape." See, also, the second paragraph on page 8, wherein it is taught that the backing thickness is important, and can vary somewhat, but must be selected so that "it possesses sufficient integrity" and exhibits "sufficient physical properties and [is] of a sufficient thickness to achieve that objective."

A person having ordinary skill in the art, reading Bries objectively, is left with the clear impression that the backing thickness should be increased as needed to avoid backing rupture while the tape is being released from the substrate. As discussed in the instant specification at page 3, lines 25-28, this is a disadvantage, as it precludes the use of the thin-layer polymeric films, which are available on the market. Accordingly, the present invention solves this problem by attacking the problem of poor adhesion to rough and irregular surfaces (see the instant specification at page 2, lines 32-37) by proceeding in the exact opposite manner. Whereas the clear emphasis in Bries is on manipulating the backing thickness to provide good overall release properties to the tape, the present invention proceeds by *manipulating the adhesive composition*.

BERND LUHMANN ET AL.
USSN 09/988,548

The result, as shown for instance in instant Example 1, is that the present invention permits the use of foam backings that would otherwise tear during the release process (Samples 3.009 and 3.010 in the last Table on page 14), but, by combining these backings with an adhesive composition of the requisite tear strength (Samples 3.001A and 3.006 in the last Table on page 14) it is possible to achieve removal of the tape from the substrate without tearing the backing. Moreover, because of the presence of the backing, the adhesion to rough and irregular surfaces is still achieved (see page 15, lines 15-18).

Claim 24 and the claims dependent thereon should be allowed because, while Bries clearly places the responsibility for tear resistance on the choice of backing material itself, claim 24 clearly places the responsibility for tear resistance on the self-adhesive composition. Thus, according to claim 24, the backing *would* tear under the conditions of removal if the self-adhesive composition were not present. The use of such “tearable” backings is not taught by Bries, nor would the use of such backings have been obvious to persons skilled in the art given Bries. In point of fact, as discussed above, Bries expressly teaches away from the use of such backings. Accordingly, the tear limitation of claim 24 also should not have been obvious.

Claims 24-35 were rejected under 35 USC § 112, first paragraph, as containing new matter. Despite the fact that Applicants explained in great detail in the preliminary amendment how the instant specification, particularly Example 1, supports the “whereby” clause of the rejected claims, the Examiner finds that “such discussion stands only for the proposition that the

BERND LUHMANN ET AL.
USSN 09/988,548

presence of a foam backing is better than no foam backing at all.” Again, the Examiner’s point is not well taken.

Samples 3.001A and 3.009, discussed on pages 14-15 of the specification, have the same type of foam backing (Alveolit TEE 0400.35 at a thickness of 350 μm and a density of 250 kg/m^3). The two samples differ only in the type of adhesive applied to both sides of the foam backing, and the amount of adhesive applied. However, whereas sample 3.009 tore when stretched, sample 3.001A did not tear. This proves two things: First, the backing is of a type that will tear if the adhesive does not provide adequate support (sample 3.009). Second, the proper choice of adhesive can provide support and prevent tearing of a backing that would tear under other circumstances (sample 3.001A).

Samples 3.006 and 3.010 are related in the same way as samples 3.001A and 3.009. The results are also similar—sample 3.010 tore, whereas sample 3.006 did not, and the only difference between the two samples is the type and amount of adhesive employed. Again, these data prove two things: First, the backing is of a type that will tear if the adhesive does not provide support (sample 3.010). Second, the proper choice of adhesive can provide support and prevent tearing of a backing that would tear under other circumstances (sample 3.006).

Respectfully, these data provide ample support for the “whereby” clause of the rejected claims. Further, since all of the samples *that Applicants relied on in the pertinent discussion in*

BERND LUHMANN ET AL.
USSN 09/988,548

the preliminary amendment contain a foam backing, it is not clear how the Examiner interpreted the data to lead to the conclusion that "the presence of a foam backing is better than no foam backing at all." Looked at with the proper objectivity, Applicants submit that the data clearly convey the concept that a backing can be selected that would tear under a given set of circumstances and, by the proper manipulation of the adhesive, the backing can be supported by the adhesive in a manner that it will not tear when an adhesive tape comprising it is removed from a substrate. As this is the exact concept claimed in the "whereby" clause of the rejected claims, the "whereby" clause does not constitute new matter. *See, e.g., In re Anderson*, 176 USPQ 331, 336 (CCPA 1973), for the proposition that in determining whether an amendment to a claim constitutes new matter, the question is not whether the added *word* is a word that is used in the application as filed, but whether the *concept* embodied by the added word is present in the original specification.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

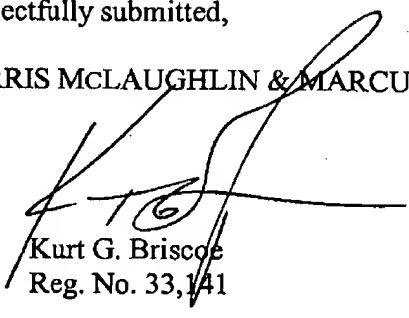
BERND LUHMANN ET AL.
USSN 09/988,548

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By


Kurt G. Briscoe
Reg. No. 33,141

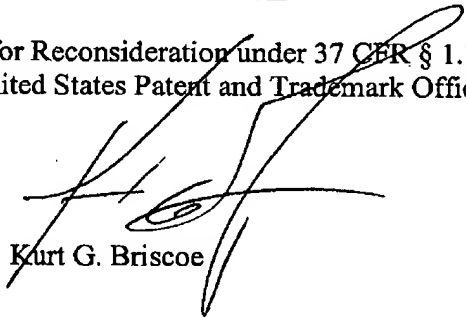
220 East 42nd Street
30th Floor
New York, New York 10017
Phone: (212) 808-0700
Fax: (212) 808-0844

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Request for Reconsideration under 37 CFR § 1.111 (10 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: May 5, 2003

By:


Kurt G. Briscoe

FAX
MAY 06 2003
GROUP 1700